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KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			RODRIGUEZ, CRIS LOIREN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHAWN W. O'DRISCOLL and DAVID G. JENSEN

Appeal 2009-000743
Application 10/731,173
Technology Center 3700

Decided:¹ June 23, 2009

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and
MELANIE L. McCOLLUM, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a bone fixation set. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Claims 3, 9-14, and 31-35 are pending and on appeal (App. Br. 1). The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). We will focus on claim 34, which reads as follows:

34. A set for bone fixation, comprising: at least three bone plates having different shapes, at least a pair of the bone plates being configured to be secured to the same left or right half of a skeleton and including the same color and at least one other of the bone plates being configured to be secured to the other half of a skeleton and including a distinct color, thereby providing a two-color system for distinguishing left bone plates from right bone plates.

Claims 3, 12-14, and 31-35 stand rejected under 35 U.S.C. § 103(a) as obvious over Henniges (US 6,592,578 B2, Jul. 15, 2003) (Ans. 3).

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Henniges in view of Streli (US 4,565,193, Jan. 21, 1986) (Ans. 5).

Claim 11 stands rejected under 35 U.S.C. § 103(a) as obvious over Henniges in view of Weaver (US 6,623,486 B1, Sep. 23, 2003) (Ans. 5).

ISSUE

The Examiner relies on Henniges for teaching “a system and method for installing plates for general bone repair” and for teaching “to color code the plates . . . for easy identification during a surgical procedure” (Ans. 3). The Examiner finds that Henniges teaches “the claimed invention except for the distinct color indicating a left or right half of the skeleton” (*id.* at 4). However, the Examiner concludes that the claimed set of bone plates would have been obvious “in order to minimize confusion during a surgical procedure” (*id.*).

Appellants contend that Henniges does not teach or suggest the bone plate set of claim 34 (App. Br. 3-9; Reply Br. 1-4).

The issue is: Have Appellants shown that the Examiner erred in concluding that the bone plate set of claim 34 would have been obvious?

FINDINGS OF FACT

1. Henniges discloses bioabsorbable plates for general bone repair (Henniges, Abstract).

2. In particular, Henniges discloses “various examples of the plates 10 . . . in different shapes and sizes, which lend themselves to use in specific regions of the head or face or body” (*id.* at col. 5, ll. 38-42).

3. Henniges also discloses that it is a “feature of the present invention, to color code the plates 10 for easy identification during a surgical procedure” (*id.* at col. 6, ll. 44-47).

4. Specifically, Henniges discloses:

By manufacturing the plates 10 with a unique color associated with each unique shape and size, confusion will be minimized and time will be saved. The color-coding will allow a doctor or nurse to identify and request the specific plate 10 and to better locate and implant screws and plates *in vivo*.

(*Id.* at col. 6, ll. 49-55.)

PRINCIPLES OF LAW

Under 35 U.S.C. § 103, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Obviousness “analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Instead, it proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421. The “suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense.” *Dystar Textilsfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006).

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

ANALYSIS

Henniges discloses plates for bone repair having different shapes (Findings of Fact (FF) 1-2). Henniges also discloses color coding the plates “for easy identification during a surgical procedure” (FF 3). Henniges does not specifically disclose a two-color system for distinguishing left bone plates from right bone plates. However, we agree with the Examiner that such a system would have been obvious in order to aid in the identification of plates during surgery.

We recognize that Henniges specifically discloses a color-coding system in which “a unique color [is] associated with each unique shape and size” (FF 4). However, we do not agree with Appellants that Henniges teaches away from the claimed two-color system. In particular, although Henniges discloses a system that is different from the claimed system, Henniges does not indicate that other color-coding systems are “unlikely to be productive.” *In re Gurley*, 27 F.3d at 553.

CONCLUSION

Appellants have not shown that the Examiner erred in concluding that the bone plate set of claim 34 would have been obvious. We therefore affirm the obviousness rejection of claim 34. Claims 3, 12-14, 31-33, and 35 fall with claim 34.

For the same reasons, Appellants have not shown that the Examiner erred in concluding that dependent claims 9-11 would have been obvious over Henniges in view of Streli or Weaver. We therefore also affirm the obviousness rejections of these claims for the reasons stated by the Examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Ssc:

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